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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,962	01/18/2002	Chisato Numaoka	7217/66291	3337
530 7590 12/26/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/052,962	Applicant(s) NUMAOKA ET AL.	
	Examiner Muriel Tinkler	Art Unit 3691	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This application has been reviewed. Claims 1-7 are pending. The rejection(s) are as stated below.

#### ***Response to Amendment***

1. Claims 1 and 7 have been amended. The Examiner has compared these claims to the specification and has accepted these claims for review.

#### ***Response to Arguments***

2. Applicant's arguments filed October 15, 2007 have been fully considered but they are not persuasive. The Applicant argues that neither Roth nor Giacalone discuss superimposing advertisement into a movie. The Examiner disagrees. Giacalone discloses the act of editing movie content for advertisement in paragraphs 42 and 43.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a); the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (US 6,285,987 B1) in view of Giacalone (2001/0052000 A1), hereafter referred to as Roth and Giacalone respectively.

11. Claims 1 and 7 discuss an advertisement space auction method and apparatus using a network to auction advertisement space within content data streamed to a recipient, comprising the steps of: storing advertisement space information in a memory

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of an advertisement space information management server, said memory being accessible by a plurality of entities connected to said network; receiving bid data submitted from at least one of said plurality of entities via said network at an auction management server, said bid data corresponding to said advertisement space information stored in said memory; and, on the basis of said bid data received, determining a winning bidder for an advertisement space corresponding to said advertisement space information. Wherein an advertisement object designated by the winning bidder is inserted into the advertisement space of the content data streamed to the recipient. Roth discloses:

- a. Storing advertisement space on a memory in page 9 and lines 19-25 of the specification, "The system also utilizes an area of memory for temporarily storing certain information. This area of memory is called the VOD area of memory. It should be understood, that as is conventional, some of the data in the tables 16B can be stored in program structures and indexes which can then be used to access the data in order to increase speed."
- b. Receiving bid data submitted from an entity, a bid corresponding to an advertisement space and determining a winning bidder in the abstract, "Proposed bids submitted by different advertisers are evaluated in real time in order to determine which particular advertisement will be displayed to a viewer", on page 5 and lines 35-37, "The appropriate advertisement called for by the winning bid is then sent from data base 16A to browser", and, on page 6 and lines 53-56, "The web server 310, view server 320, bidding agents 30 and bid input server 18 can

all be implemented by computer programs that are all resident in and executed by one single physical computer."

12. Roth does not disclose: auctioning advertisement space within content data streamed to a recipient; an advertisement space information management server; an auction management server; and, an advertisement object designated by the winning bidder is superimposed into the advertisement space of the content data streamed to the recipient, said content data being a movie. Giacalone teaches:

- a. Auctioning advertisement space within content data streamed to a recipient in paragraph 19, "Yet, another aspect of the present invention relates to the provision of a method of selling electronic advertising. The advertising need not be limited to public space displays and can include broadcast advertising, or any other form of advertising applicable to any digital electronic advertising system... The process is fully automated such that the winner of the auction has its advertisement played and he is automatically billed";
- b. An advertisement space information management server and an auction management server in the Abstract, "A server is coupled to the database. The server is capable of receiving input preferences relating to parameters selected from the group consisting of: frequency, interval, time of play, and trigger events. A scheduling algorithm is executed on the server for generating schedule data... A network is coupled between the database and the server for distributing the content and the schedule data to a plurality of output devices";

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c. And, an advertisement object designated by the winning bidder is superimposed into the advertisement space of the content data (movie) streamed to the recipient in paragraphs 20, 42 and 43, "Still another feature of the present invention relates to the integration of data streams from corporation information, Internet data or other data sources into advertising both as to the content and the scheduling of advertisement play rather than having to constantly re-author electronic media to reflect changing business and retail situations. The advertising system can actually take the data in live and readjust the media that is being played to reflect the current situation in real time... An example of this updating feature is where one has a catalog, for instance, that has both pictures and prices. The present invention can seamlessly integrate both the pictures and the prices such that when an item goes on sale, it will promote that sale using the old pictures but the new sale price, and automatically bring this information to the screen by virtue of a trigger that indicates that the item is on sale." The system can be used with movies, "This is a tool that works within the system interface and provides the user with a step by step method for importing still frames or movies and turning them into valid content." Also, the movie content can be edited, "By using the dynamic data manager, the user of the system can change the way an ad appears when it is rendered by the AdPlayer"

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Roth to include auctioning advertisement space within content data streamed to a recipient, an advertisement space information

management server; an auction management server and, an advertisement object designated by the winning bidder is inserted into the advertisement space of the content data streamed to the recipient because, as stated in paragraph 11 of Giacalone, "it allows a large network of advertising, and display or broadcast of communicative messages or images or any other kind of digital content to be created, it allows each of the displays to have unique content presented upon them, and it allows the content on each display to be changed, in whole or in part without manual intervention at the point of display."

13. Claim 2 discusses the advertisement space auction method according to claim 1, wherein said advertisement space information contains information indicating a period of time allowed for submitting said bid data; and said winning bidder is determined on the basis of a plurality of said bid data submitted during said period of time allowed therefor. Claims 1 and 8 have been rejected based on the information disclosed above. Roth discloses on page 7 and lines 26-33, "Bidding agents 30 must be programmed to evaluate proposed bids in a certain amount of time and to submit actual bids to server 320 within pre-established time limits. If server 320 does not receive a bid from a particular bidding agent 30 within a certain time, it assumes that it will not receive a bid from that bidding agent and it selects the highest bid from the bids received from the other bidding agents."



14. Claim 3 discusses the advertisement space auction method according to claim 1, wherein said advertisement space information contains data on recipient addressees scheduled to receive an advertisement. Claims 1 and 8 have been rejected based on the information disclosed above. Roth discloses on page 17 and lines 56-67, "Web Server 310: The web server 310 is a conventional web server which is programmed to provide two main functions: 1) Answer and hold the state of each HTTP request; deliver the view-op to the system kernel in view server 320; receive the system kernel reply and deliver the content. This is a multi-task operation. The contents (the IP data) of each view op, along with its type (either a request for content or a click-through) are delivered to the view server 320. This communication is through shared memory or alternatively it may be through a conventional inter-computer network." Roth discloses on page 7 lines 55-56 through and page 8 lines 20-28, "The following terms are used herein with the following meaning... IP Data: Data about the viewer which is specified using the Internet protocol. The IP data about a viewer is presented to the system at view-op time in accordance with standard HTTP conventions. The IP data is defined by standard HTTP conventions and it includes: CGI (common graphic interface) variables, Browser type (e.g. Netscape), viewers URL, high-level domain (.edu, .gov, .com, OS of viewer (MAC, Windows, etc.), host, IP address, and URL of referring Web page."

15. Claim 4 discusses the advertisement space auction method according to claim 1, wherein said advertisement space is determined corresponding to a distribution cluster of recipient addressees that receive an advertisement inserted in said advertisement

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space, said distribution cluster containing a plurality of entities having a common characteristic; said advertisement space information containing data on said common characteristic; and, said advertisement space information contains evaluation information on said advertisement space designated in said advertisement space information. Claims 1 and 8 have been rejected based on the information disclosed above. Roth discloses on page 13 and lines 51-56 of the specification, "Each proposed bid (i.e. each form object) may contain a wide range of criteria that must be satisfied if an actual bid is to be placed. The criteria may be very stringent in a situation where the proposed bid is high and the advertiser wants to reach only a very select group of viewers."

16. Claim 5 discusses the advertisement space auction method according to claim 1, wherein said advertisement space information contains evaluation information on said advertisement space designated in said advertisement space information. Claims 1 and 8 have been rejected based on the information disclosed above. Roth also discloses on page 4 and lines 20-21, "Advertisers submit proposed bid, to their associated bidding agents for evaluation against view-ops."

17. Claims 6 discusses the advertisement space auction method and storage medium according to claim 1, wherein said network is an open network accessible by a plurality of general public users. Claims 1 and 8 have been rejected based on the information disclosed above. Roth discloses on page 1 and lines 4-7 of the specification, "The


present invention relates to computer networks and more particularly to a method and system for selecting and then displaying advertisements on Internet World Wide Web sites."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
HANI M. KAZIMI  
PATENT EXAMINER